

In re Lasch, et al.
U.S. Patent Application No. 10/749,006

REMARKS

Claims 1-29 are currently pending. The present reply is submitted in response to the Office Action dated July 26, 2007. In the Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. In addition, the Examiner rejected claim 27 under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Moreover, the Examiner rejected claims 1 and 27 as provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 5, and 25 of copending U.S. patent application no. 11/044,662.

Still further, the Examiner rejected claims 1-14, 18-20, 22, and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over Conner (2005/0194453) in view of Roberts (U.S. Patent No. 6,025,283) and further in view of Robinson et al. (U.S. Patent Application No. 2003/0047253). In addition, claims 15-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Conner, modified by Roberts and Robinson et al., and further in view of Kaminsky (2004/0121257). Claims 21 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Conner, modified by Roberts and Robinson et al., and further in view of Hinata (2003/0202151). Claims 23-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Conner, modified by Roberts and Robinson et al., and further in view of Makishima (U.S. Patent No. 3,468,046) and Biller (2003/0150762). Finally, claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Conner, modified by Robert and Robinson et al, and further in view of Hara (U.S. Patent No. 4,876,441). New claims 26-29 have been added to the present application.

In re Lasch, et al.
U.S. Patent Application No. 10/749,006

Rejection of Claim 1 under 35 U.S.C. § 112, First Paragraph

Claim 1 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that there is no support found in the specification that "at least 8 mils" of the claimed metal layer comprises embossed characters. In addition, the Examiner states that the terms "at least" would give rise to an infinite upper limit that the specification does not encompass.

Applicants respectfully submit that claim 1 is not amended to define:

a first layer of metal selected from the group consisting of titanium and stainless steel, wherein said first layer of metal has a thickness of between 8 mils and 30 mils, wherein said first layer of metal has a portion that is thinner than the remainder of the first layer of metal;

embossed characters in the metal layer disposed in the portion that is thinner than the remainder of the first layer of metal, said embossed characters protruding from a surface of the transaction card.

Applicants respectfully submit that these claim limitations are described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, support for these claim limitations can be found on page 11, lines 13-14, page 12, lines 9-11, page 13, lines 9-11 and page 14, lines 8-9. The application, at these citations, disclose various embodiments of transaction cards according to the present invention. For example, one embodiment preferably discloses that the metal layer is about 30 mils, although other thicknesses are contemplated (see page 11, lines 13-14). Another embodiment discloses that the metal layer is about 6 mils, although other thicknesses are contemplated (see page 13, lines 9-11). It is apparent that transaction card are specifically disclosed having thicknesses from 6 mils up to 30 mils, and Applicants clearly indicate that other thicknesses are contemplated.

In re Lasch, et al.
U.S. Patent Application No. 10/749,006

The claimed invention, of a first layer of metal having a thickness of between 8 mils and 30 mils, falls within the range specified in the application.

Moreover, Applicants have amended the claims to define a first layer of metal having "a thickness of between 8 mils and 30 mils," thereby rendering the Examiner's rejection based on the term "at least" moot. Applicants respectfully submit that the amendment to independent claim 1 overcomes the rejection by the Examiner under 35 U.S.C. § 112, first paragraph.

Rejection of Claim 27 Under 35 U.S.C. § 112, Second Paragraph

Claim 27 was rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention by reciting the limitation "said first layer" in lines 2 and 4. The Examiner maintains there is no antecedent basis for this limitation in the claim.

Applicants have amended claim 27, lines 2 and 4, to remove "first" as a modifier of "layer of metal." Applicants respectfully submit that the amendments to claim 27 overcomes the rejection under 35 U.S.C. § 112, second paragraph.

Rejection of Claims 1 and 27 Under 35 U.S.C. § 103(a)

With respect to the rejection of independent claims 1 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Conner et al. in view of Roberts and Robinson et al., Applicants respectfully submit that the claims, as amended, define the invention over Conner et al., Roberts, Robinson et al., or any other cited reference of record, taken alone or in combination. More specifically, independent claim 1 has been amended to define:

a first layer of metal selected from the group consisting of titanium and stainless steel, wherein said first layer of metal has a thickness of between 8 mils and 30 mils, wherein said first layer of metal has a portion that is thinner than the remainder of the first layer of metal,

and

In re Lasch, et al.
U.S. Patent Application No. 10/749,006

embossed characters in the metal layer disposed in the portion that is thinner than a remainder of the first layer of metal, said embossed characters protruding from a surface of the transaction card.

Moreover, claim 27 has likewise been amended to define:

said first layer of metal comprises a portion that is thinner than a remainder of the first layer of metal wherein embossed characters are disposed in the portion that is thinner than the remainder of the first layer of metal, said embossed characters protruding from a surface of the transaction card

Neither Connor et al., Roberts nor Robinson et al. teaches or discloses a transaction card having these features. The Examiner, when rejecting claim 23 having a similar scope as newly amended independent claims 1 and 27, stated:

Regarding claim(s) 23, Roberts discloses a card having a recessed pocket from which embossed characters are protruded by the embossing process so that the thickness of the card conforms with ISO standard thickness. See the following text:

“Advantageously, to conform with ISO standards, the card can be milled out to provide a recess of 600 micron to accommodate SMART card technology and can thereafter be embossed.” (col. 4, lines 46-49).

Applicants respectfully submit that the Examiner has misread, misunderstood and, consequently, misapplied Roberts in rejecting claim 23. Specifically, when looking at the citation, it is apparent that the card is milled out specifically to accommodate only SMART card technology, and not to provide a thinner portion, relative to the remainder of the metal layer, where embossed characters are disposed to protrude from a surface of the transaction card. It is the card that is “thereafter . . . embossed,” not the recess of 600 microns. Roberts is merely providing step-wise instructions on how to create a card having the SMART card technology, and that is embossed. First, Roberts teaches, the card is provided with a recess of 600 microns to accommodate SMART card technology. Next, Roberts teaches, the card is embossed.

In re Lasch, et al.
U.S. Patent Application No. 10/749,006

There simply is no recognition in Roberts of the problem solved by the present invention, that is the difficulty of embossing characters in relatively hard and rigid layers of titanium or stainless steel, let alone the solution of embossing characters in a portion of the titanium or stainless steel that is thinner than the remainder of the layer of titanium or stainless steel.

Roberts did not intend to teach or disclose what the Examiner claims. Indeed, in the same paragraph cited above by Examiner, Roberts describes the information that is embossed in the card, including "the number 11 attached to the card, the dates 12, 13 of first validity and expiry and the name 14 of the card owner are all embossed into the card." (Col. 4, lines 54-57). Referring to FIGs. 1-3, these embossed characters are nowhere disposed in a portion that is thinner than the remainder of the first layer of metal, as required by the present invention. FIG. 2 illustrates a back side of the card, including a "magnetic strip 16" and a "signature patch 17," and does not include the required thinner portion FIG. 3 illustrates a cross-section of the charge card of FIGS. 1 and 2, and likewise does not disclose a portion thinner than a remainder of the first layer of metal for disposing embossed characters, said embossed characters protruding from a surface of the card, as required by independent claim 1 and 27.

Therefore, contrary to the Examiner's assertion, Roberts fails to disclose the elements of amended independent claims 1 and 27. Moreover, neither Conner et al. and Robinson et al. supply the missing elements. Since Conner et al., Roberts and Robinson et al. fail to teach or suggest the elements defined in amended independent claims 1 and 27, the rejections thereto have been overcome and, respectfully, should be withdrawn.

Claims 4-26 depend from independent claim 1; and claims 28-29 depend from independent claim 27. These claims are further believed allowable over the references of record

In re Lasch, et al.
U.S. Patent Application No. 10/749,006

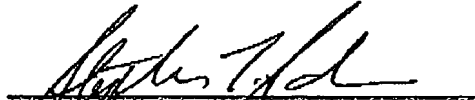
for the same reasons set forth above with respect to their parent claims, since each sets forth additional structural elements of Applicants' novel transaction card.

CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully submit that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicants urge the Examiner to telephone Applicants' attorney so that the same may be resolved and the application expedited to issue. Applicants respectfully request the Examiner to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Stephen T. Scherrer
Registration No. 45,080

227 West Monroe Street
Chicago, IL 60606-5096
Phone: 312.372.2000
Facsimile: 312.984.7700
Date: October 23, 2007

Please recognize our Customer No. 1923
as our correspondence address.

CHI99 4891225-1.037355.0169